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JONES & SMITH, LLP 2777 ALLEN PARKWAY, SUITE 800 HOUSTON, TX 77019-2141			PATEL, DHIRUBHAI R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EVA ACKERMAN and RANDY GENE CLARK

Appeal 2007-2373
Application 09/764,572
Technology Center 2800

Decided: December 21, 2007

Before KENNETH W. HAIRSTON, ANITA PELLMAN GROSS,
and MARC S. HOFF, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Ackerman and Clark (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 23 through 27, 37, 38, and 40, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a fire retardant gasket between a faceplate and an electrical box. *See generally* Spec. 2:20-3:19. Claim 23 is illustrative of the claimed invention, and it reads as follows:

23. A method of assisting a compromised barrier, comprising:

- a) providing a gasket comprising fire retardant material of a fire resistant insulative material containing mineral wool or intumescient graphite;
- b) placing the fire retardant gasket between a faceplate and an electrical box adapted to be introduced into the barrier;
- c) coupling the faceplate to the box; and
- d) at least partially reestablishing a fire rating of the barrier.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Close, Jr.	US 4,163,137	Jul. 31, 1979
Landin	US 6,153,674	Nov. 28, 2000
Dykhoff	US 6,521,834 B1	Feb. 18, 2003
		(filed Aug. 25, 2000)

Claims 23 through 27, 37, 38, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dykhoff.

Claims 23 through 26, 37, 38, and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Close in view of Landin.

The rejection of claims 23 through 27 under 35 U.S.C. § 112, second paragraph, has been withdrawn. (*See* Ans. 3.)

We refer to the Examiner's Answer (mailed March 7, 2007) and to Appellants' Brief (filed November 20, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse both the anticipation rejection of claims 23 through 27, 37, 38, and 40 and also the obviousness rejection of claims 23 through 26, 37, 38, and 40.

OPINION

Appellants' sole argument regarding the anticipation rejection of claims 23 through 27, 37, 38, and 40 over Dykhoff is that the Declaration of Randy Clark (with the accompanying Exhibits) filed March 30, 2004, establishes completion of the invention prior to August 25, 2000, the effective filing date of Dykhoff. (*See Br. 6-7.*) Specifically, Appellants contend that Exhibit A describes a gasket of intumescent material behind a cover plate of an outlet box, Exhibit B describes the intumescent material as being hydrated aluminum silicate and acid treated flake graphite, and Exhibits C, D, and E relate to reestablishment of the fire rating of the barrier using the intumescent gasket. Appellants do not dispute the disclosure by Dykhoff of any claim limitations. The Examiner (Ans. 13) asserts that the Declaration and Exhibits fail to establish

a method of assisting a compromised barrier comprising:
placing the fire retardant gasket between a faceplate and an electrical box, coupling the faceplate to the box, and at least partially reestablishing a fire rating of the barrier. No data related to any fire rating as well as at least partially reestablishing a fire rating of the barrier[.]

The issue, therefore, is whether the Declaration and Exhibits establish completion of the claimed invention prior to the filing date of Dykhoff.

Appellants' Declaration indicates that all five exhibits predate August 25, 2000, the filing date of Dykhoff, and, therefore, anything established by the Exhibits predates Dykhoff. Appellants' Exhibit A, an e-mail to inventor Randy Clark from Mr. Richard N. Walke of UL Laboratories, discusses a gasket of intumescent material used for fire protection located behind cover plates of outlet boxes. Further, the e-mail mentions two successful tests of the gaskets including F0419029. Exhibit A thus establishes placing a gasket of intumescent material between a cover plate and an outlet box for fire protection. Further, Appellants indicate in the Declaration that the test F0419029, referenced in Exhibit A, "refers to a 2-hour maximum rated barrier having an intumescent gasket rated for 2 hours." Accordingly, the success of the test mentioned in the e-mail of Exhibit A establishes partially establishing a fire rating of the barrier (for two hours).

The only limitation of independent claims 23 and 37 not established by Exhibit A in combination with the Declaration is material of the gasket containing mineral wool or intumescent graphite. However, Exhibit B shows the material of an intumescent sheet as containing hydrated aluminum silicate and acid treated flake graphite. Exhibit B is discussed in the Declaration as showing the composition of the intumescent gasket. Exhibits C and D each have F0419029 written thereon and are discussed in the Declaration as showing the results of test F0419029 of the gasket. Further, both show a passing result. Thus, the combination of the Declaration and Exhibits A through D establishes the claimed invention prior to Dykhoff, thereby removing Dykhoff as prior art. Consequently, we cannot sustain the anticipation rejection over Dykhoff.

Regarding the obviousness rejection of claims 23 through 26, 37, 38, and 40 over Close in view of Landin, the Examiner asserts (Ans. 9) that it would have been obvious to replace the fire retardant gasket of Close with a fire resistant material of mineral wool or intumescent graphite as taught by Landin to "prevent transfer of heat from a fire across the barrier."

Appellants contend (Br. 7) that there is no reason to combine Close and Landin especially "since the plastic gaskets of *Close* are used to prevent air infiltration and thus cool air into the room." The issue, therefore, is whether it would have been obvious to substitute Landin's intumescent graphite for Close's fire retardant gasket.

As contended by Appellants, Close discloses (col. 2, ll. 33-34) a fire retardant gasket between an electrical box and its cover plate "to provide an improved air infiltration seal." Further, the gasket "seals against air infiltration and flow across panel **36** to prevent cool air from flowing into the room" (see col. 3, ll. 55-59). Landin, as inferred by Appellants, discloses (col. 1, ll. 4-6 and 51-55, col. 10, ll. 54-57, and col. 11, ll. 4-12) a fire barrier material that allows for dissipation of heat at room temperature. To substitute the material of Landin for the gasket of Close would result in a gasket that allows air to flow through the wall, thereby defeating the purpose of Close. The Federal Circuit has held that "a proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)." *In re Fritch*, 972 F.2d 1260, 1265-66 n.12 (Fed. Cir. 1992). Consequently, we cannot sustain the obviousness rejection of claims 23 through 26, 37, 38, and 40 over Close in view of Landin.

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ORDER

The decision of the Examiner rejecting claims 23 through 27, 37, 38, and 40 under 35 U.S.C. § 102(e) and claims 23 through 26, 37, 38, and 40 under 35 U.S.C. § 103 is reversed.

REVERSED

tdl/gvw

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